REMARKS

Reconsideration of the present application in view of the following remarks is respectfully requested. Each of claims 2, 3, 73-75 and 77-109 is currently pending and under consideration, claims 110-116 have been withdrawn from consideration and claims 1, 4-72 and 76 have been cancelled.

The outstanding Office Action has maintained multiple claim rejections based upon a combination of references, including, among others, U.S. Patent No. 6,039,762 to McKay (hereafter "the '762 patent"). The '762 patent had been previously asserted against the subject application but was subsequently removed upon the Applicants' showing of entitlement to an effective filing date preceding the effective date of the '762 patent. The Examiner has now asserted, at page 2 of the outstanding Office Action, that "applicant is in error concerning establishment of the date to application 08/740,031. It appears that the current application was filed after the abandonment date of the earlier filed application." More particularly, the Office Action asserts that the January 18, 2000 filing date of Application Serial No. 09/484354 (hereinafter "the '354 application") occurred after Application Serial No. 08/740031 (hereinafter "the '031 application") became abandoned, which allegedly occurred on October 21, 1999.

The subject application is a continuation of Application Serial No. 10/114,675, filed April 2, 2002, which is a continuation of the '354 application, filed January 18, 2000, which is a divisional of the '031 application, filed October 23, 1996. As will be set forth below and in the Exhibits attached hereto, it is respectfully submitted that the '031 application did not become abandoned on October 21, 1999, as asserted by the Office Action. Consequently, it is further submitted that the '354 application was properly filed during the pendency of the '031 application.

Referring now specifically to the '031 application, a Notice of Appeal was properly filed during the prosecution thereof on August 16, 1999, in response to an Office Action dated February 16, 1999. A copy of the Notice of Appeal is attached hereto as Exhibit A.

The filing of the Notice of Appeal established an initial deadline of October 16, 1999, for Applicants to submit an Appeal Brief, which Appeal Brief deadline was extendable under the provisions of 37 C.F.R. §1.136(a). On January 18, 2000, a Request for Extension of Time of three months, up to and including January 18, 2000, for filing an Appeal Brief and a Fee Transmittal Form authorizing payment of the appropriate fee were filed with respect to the '031 application. Copies of the Request for Extension of Time and the related Fee Transmittal Form are attached hereto as Exhibits B and C, respectively. It should be noted that the five month deadline for submitting the Appeal Brief expired on January 16, 2000, which fell on a Sunday. The following day, January 17, 2000, was a national holiday and the Patent and Trademark Office was closed. Consequently, Exhibits B and C were timely and properly filed on January 18, 2000, in accordance with 37 C.F.R. §1.7(a). Moreover, Exhibit B indicates that it was mailed on January 18, 2000, via United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R §1.10.

In view of the above, it is clear that the '031 application remained pending up to and including January 18, 2000. Thus, the January 18, 2000 filing date of the '354 application, as verified on a copy of the Filing Receipt thereof attached hereto as Exhibit D, occurred during the pendency of the '031 application. Accordingly, Applicants submit that the subject application is properly entitled to claim priority to at least the October 23, 1996 filing date of the '031 application and to a filing date preceding the effective date of the '762 patent. As a result, Applicants submit that the rejection of claims over all combinations that include the '765 patent is overcome and that removal of "the previous rejection mailed 4/5/05" and "the last rejection to the claims mailed 2/28/2006", as reinstated on Page 2 of the outstanding Office Action, is proper.

In addition to the above, the outstanding Office Action reasserts claim rejections based on a combination of Grivas et al., Heggeness et al. and either of O'Leary et al. or Prewett et al. These rejections are discussed on pages 8-13 of the Office Action. Applicants respectfully submit that the outstanding Office Action has not fully considered Applicants' arguments and amendments relating to this combination that were submitted in the responses

dated June 27, 2006 and December 4, 2006. Particularly, the outstanding Office Action indicates, on page 13, that "[a]pplicant's arguments filed 12/4/2006 have been fully considered but they are not considered persuasive." However, the Manual of Patent Examining Procedure (MPEP) §707.07(f) instructs "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Moreover, MPEP §707.07(f) further instructs the Examiner to "provide explanation as to non-persuasiveness." To the contrary, the outstanding Office Action has not answered the substance of any of Applicants' previous arguments, nor has it provided any explanation as to non-persuasiveness. Moreover, these same grounds for rejection have been repeated verbatim three times through the Office Actions dated April 3, 2007, July 31, 2006 and February 28, 2006. At no time have Applicants' arguments been addressed as set forth in MPEP §707.07(f).

For these reasons, it is believed that the prior amendments and arguments relating to this combination of references may have been overlooked. Applicants therefore present the arguments again below for the convenience of the Examiner. Because the claim amendments were previously submitted for entry, the claim amendments are not presented again herein, but rather the claims are set forth above in their previously-amended form. Applicants further submit that after removal of the '762 patent as prior art as indicated above, the following arguments and amendments support the prior patentability of each of claims 2, 3, 73-75 and 77-109 over the remaining references of record.

Reiteration of prior arguments:

Applicants again acknowledge and thank the Examiner for the indication in the outstanding Action that claims 83 and 84 recite allowable subject matter. The Action states that these claims are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For the reasons stated herein, Applicants submit that the base claim and the intervening claims are also in condition for allowance, and that this objection to claims 83 and 84 is therefore moot. Withdrawal of this objection is therefore respectfully requested.

Claims 2, 3, 73-82, 85-92 and 94-106 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Grivas et al. (5,814,084) in view of Heggeness, et al. (5,514,180) and either of O'Leary et al. (5,290,558) or Prewett et al. (5,314,476). Applicants traverse this rejection and submit that the claims are patentable over the cited combination of references.

Independent claim 73 has been amended to specify that the spinal spacer comprising a cylindrical bone dowel has an osteogenic composition impregnated therein. It is worthy of note that no suggestion has been made in the outstanding Action that the cited combination of references calls into question the patentability of current claim 73, as amended. Applicants submit that none of the cited references, either alone or in combination with one another, suggests or contains any teaching that might lead a person of ordinary skill in the art to impregnate a bone dowel with an osteogenic composition including a substantially pure osteogenic factor as recited in pending claim 73, as amended. The primary reference cited in the outstanding Office Action, the Grivas patent, is relied upon in the outstanding Action as disclosing "a spinal spacer for insertion into a disc [sic] space between adjacent vertebrae including a cylindrical bone dowel having a chamber filled with osteogenic material that services to promote rapid fusion of the vertebrae." The Grivas patent, however, is devoid of any teaching or suggestion of impregnating an osteogenic composition into a bone dowel, as recited in claim 73 of the present application, as amended. Indeed, the desirability of the claimed invention is taught only by the present application.

The secondary reference, Heggeness et al., is relied upon in the outstanding Action as disclosing "the use of [BMP] proteins to foster and induce new tissue formation to promote fusion between the vertebrae and the spinal spacer." Heggeness et al., however, likewise is devoid of any teaching or suggestion of impregnating an osteogenic composition into a bone dowel, as recited in claim 73 of the present application, as amended. In addition, neither Grivas et al. nor Heggeness et al. discloses or suggests the use of a substantially pure osteogenic factor in a spinal spacer, as recited in claim 73. In view of the above, Applicants

submit that claim 73, as amended, is in condition for allowance, and respectfully request withdrawal of the rejection thereof that is asserted in the outstanding Office Action.

Claims 2, 3, 74-75 and 77-93 depend, either directly or indirectly, from independent claim 73. Applicants submit that these dependent claims recite patentable subject matter for at least the same reasons that the subject matter of independent claim 73 is patentable, and for other reasons. While dependent claim 92 is rejected in the outstanding Action over a different combination of references, including the above-cited references and an additional reference (Brekke), Applicants submit that this combination also fails to teach or suggest the invention recited in claim 92 for the same reasons that the cited references fail to teach or suggest the invention recited in independent claim 73, as amended. Brekke has the same deficiencies as Grivas et al. and Heggeness et al., and does not provide any teaching or suggestion of the claimed invention.

Applicants submit that independent claim 94, as amended, is also in condition for allowance. The invention recited in claim 94, as amended, is patentable over the cited references at least because this claim recites an element that is not disclosed or suggested in any of the references or record, namely, a "substantially pure osteogenic factor." None of the cited references teaches or suggests the use of a "substantially pure osteogenic factor" in any manner, much less in connection within a dowel comprising bone graft, as recited in claim 94. It is axiomatic that an asserted combination of references fails to support a rejection of a patent claim under Section 103 of the Patent Statute where the claim recites an element or feature that is absent from the cited references. In other words, in order for an asserted combination to be proper, not only must the references themselves or other prior art contain a suggestion that would motivate a person of ordinary skill in the art to combine the teachings of the references, but in addition, once they are combined, the combination must include all elements of the claimed invention. Applicants submit that the references of record fail to support a rejection of claim 94 in the present case because none of the cited references, even if properly combined, teaches or suggests the use of a "substantially pure osteogenic factor." Applicants therefore submit that the asserted rejection of claim 94 must be withdrawn. In

view of the above, Applicants submit that claim 94, as amended, is in condition for allowance, and respectfully request withdrawal of the rejection of claim 94 that is asserted in the outstanding Office Action.

Claims 95-115 depend, either directly or indirectly, from independent claim 94. Applicants submit that these dependent claims recite patentable subject matter for at least the same reasons that the subject matter recited in independent claim 94 is patentable, and for other reasons. While dependent claims 107-109 are rejected in the outstanding Action over a different combination of references including the above-cited references and an additional reference (Bianchi), Applicants submit that this combination also fails to teach or suggest the invention recited in claims 107-109 for the same reasons that the cited references fail to teach or suggest the invention recited in independent claim 94, as amended.

In view of the foregoing remarks, Applicants respectfully submit that none of the rejections asserted in the outstanding Action can properly be maintained. Accordingly, reconsideration leading to withdraw of all the rejections under 35 U.S.C. § 103(a) and allowance of this application containing claims 2, 3, 73-75 and 77-109 are respectfully requested.

Conclusion

In view of the above, Applicants respectfully submit that the rejections stated in the outstanding Action are overcome and that the present application is in condition for allowance. Action to that end is respectfully requested. If there are any remaining issues that can be addressed telephonically, the Examiner is invited to contact the undersigned to discuss the same. Nothing in this document is intended to be an admission that any of the cited references qualifies as prior art. Rather, Applicants expressly reserve the right to make showings at a later time to remove/disqualify one or more references from the prior art, if appropriate.

Respectfully submitted,

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